Remarks

Form 1449 Reference List

The Examiner crossed through two reference citations in the submitted Form 1449 submitted by Applicants. A handwritten notation next to the citations appears to state "no date". The references crossed through by the Examiner do not have a written date on their face. Accordingly, it is respectfully urged that Applicants have complied with the rules regarding citation of references to the extent that is possible. The Examiner is requested to consider the references cited and to indicate if the Examiner considers the references alone or in combination to be the basis for a rejection of any of the claims.

Status:

Claims 127-143 and 161-165 are rejected under 35 USC 112. Claims 127, 131, 133, and 134 are rejected under 35 USC 102b. Claims 127-131 and 133-135 are rejected under 35 USC 102(e). Claims 127, 132, 135,-143, and 161-165 are rejected as obvious. Claim 136 is amended. Claims 127-143 and 161-165 are pending.

Support for the amendment to claim 136 to add reference to laser is found in the application as originally filed. No new matter is added.

112 Rejections:

The Examiner rejects 127 and 136 stating the meaning of the term "storing primary data in a memory device associated with the delivery device prior to an energy application" is unclear because, according to the Examiner

> "...it is unclear how applicant is construing this term to read over Chin et al. when a reading of the Abstract thereof shows such storage."

It is respectfully urged this is not a proper rejection under 35 USC 112. Instead, the Examiner seems to be reciting a rejection based on prior art, not on the grounds of

indefinetness. In particular, it is not clear how the Abstract of Chin et al. is pertinent to whether or not the claims meet the requirements of 35 USC 112. The Examiner is respectfully requested to withdraw the rejection or point out in a non-final rejection what specifically the Examiner believes is indefinite about the claims so that Applicant has a fair opportunity to respond.

The Examiner also states that the claims are indefinite because according to the Examiner, the meaing of primary data and suitability is not clear "in view of Applicants assertion that data such as power level calibration and maximum time of usage are not primary data and that preventing the re-use of disposable assemblies is not a determination of suitability". The Examiner is respectfully to point out where the applicants have made such an assertion, and to explain how such an assertion, if made, renders the claims unclear. Explanation by the Examiner in a non final rejection is respectfully requested so that the Applicants have a fair opportunity to respond.

The Examiner is also respectfully invited to call the undersigned at 513 337 3535 to discuss this so that progress can be made in prosecuting this applications.

Rejection under 35 USC 102(b)

Claims 127, 131, 133, and 134 are rejected as anticipated by Chin et al. The Examiner states that Chin et al clearly anticipates these claims. The explanation given by the Examiner is that :

> "Chin et al. teach storing primary data (see abstract and Figure 2, element 36), which includes delivery device operational parameters; connecting the device to a generator (see Figure 1); communicates data to a microprocessor therein (Figure 4); and determining the suitability of the device (see column 5, lines 2-5).

It is respectfully urged that the Office Action does not specifically apply the Chin et al. reference to the specific limitations set out in the rejected claims. It is respectfully urged that the Chin et al. reference does not teach each of the limitations of Claim 127. Note that the primary determination made in Chin et al. appears to be whether the medical device is within warranty, which is based on the number of use cycles and/or sterilization cycles. It is respectfully urged that the claims distinguish over Chin et al. In particular, it is not clear how Chin et al. teaches storing primary data, where the primary data is selected from the group set forth in Claim 127. Nor is it clear how Chin et al. stores primary data prior to energy application. The Examiner is asked to explain how Chin et al. Figure 4 illustrates such a limitation.

Claims 127-131 and 133-135 stand rejected under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent 5,742,718 to Harman et al. The explanation in the pending Office Action in applying the Harman et al. reference is that "The presence of a recognized code allows the readability of the data to be determined." It is respectfully urged that Applicants are left to interpret the reference and such comment without adequate direction. It is requested that the Examiner withdraw the rejection or supply a clear explanation of the rejection under this reference in a non-final rejection so that Applicants have a fair opportunity to respond.

Additionally, as set forth in the previous amendment, it is respectfully urged that Harman et al.'s teaching is not comparable with the primary data as set forth in amended Claim 127. It is not seen where Harman et al. utilizes information as recited in Claim 127 to determine the suitability of a fiber optic delivery device Accordingly, Applicants traverse the rejection of amended claim 127, as well as claims 128-131 and 133-135 depending directly therefrom for the above reasons.

103 Rejection:

Claims 127, 132, and 135-143 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Harman et al. patent in combination with U.S. Patent 5,383,874 to Jackson et al.

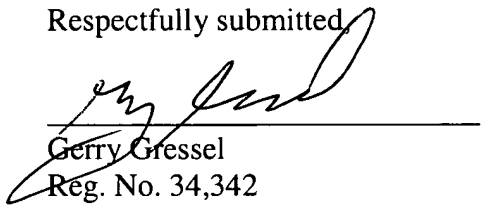
This rejection is improper for reasons set forth above with respect to Harmen et al, and in view of the reasons set forth in the previous amendment.

The Examiner is respectfully requested to provide the motivation in prior art, for combining the references as suggested by the Examiner.

Further, even if the Harman et al. and Jackson et al. references were combined as suggested by the Examiner, it is not clear from where/what in the prior art "energy limits from calibration parameters" is taught (see Claim 136), or how that teaching (assuming it is in the prior art) would teach all the limitations of the amended claims. Clarification or withdrawal of the rejection is requested.

The Examiner is respectfully requested to reconsider and allow the claims as amended, or to provide a non-final rejection setting forth reasons for the rejection to which the Applicant may respond. Should the Examiner have any questions regarding this matter or believes that a telephone discussion would be beneficial toward coming to agreement on the case, he is encouraged to contact the undersigned attorney, Gerry Gressel, at (513) 337-3535.

Respectfully submitted,



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